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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,774	03/26/2001	Sunghwa Choe	2225-0020	7797

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ROBINS & PASTERNAK LLP
545 MIDDLEFIELD ROAD
SUITE 180
MENLO PARK, CA 94025

EXAMINER

BAUM, STUART F

ART UNIT PAPER NUMBER

1638

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,774

Applicant(s)

CHOE ET AL.

Examiner

Stuart Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 10, 14-16, 18-21 drawn to an isolated polynucleotide, recombinant vector comprising of said polynucleotide, a method for producing a transgenic plant with an altered phenotype, classified in class 800 subclass 290 for example.
- II. Claims 9, 11, 17, 35-38 drawn to a recombinant vector comprising a heterologous coding sequence, host cell, classified in class 536 subclass 23.1 for example.
- III. Claims 12-13 drawn to a method of making a protein, classified in class 435 subclass 69.1 for example.
- IV. Claim 22 drawn to a method of inhibiting expression of *dwf5*, classified in class 800 subclass 290 for example.
- V. Claim 23 drawn to a method of transforming a plant with two polynucleotides classified in class 800 subclass 290 for example.
- VI. Claims 24-25 drawn to a method of increasing DWF5 activity, classified in class 800 subclass 290 for example.
- VII. Claim 26 drawn to a method of modulating an endogenous DWF5 polypeptide wherein expression of a polynucleotide is inhibited, classified in class 800 subclass 290 for example.

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- VIII. Claims 27-31 drawn to a method of altering the biochemical activity of a cell classified in class 435 subclass 468 for example.
- IX. Claims 32-34 drawn to a method for regulating the cell cycle of a plant, classified in class 435 subclass 468 for example.
- X. Claim 39 drawn to a chimeric polypeptide comprising a DWF5 polypeptide and a heterologous polypeptide, classified in class 530 subclass 402 for example.

For the restriction election to be complete, Applicant is to select a corresponding pair of sequences from the list below:

- A. SEQ ID NO:28 encoding SEQ ID NO:29, corresponding to a DWF5 polypeptide.
- B. SEQ ID NO:30 encoding SEQ ID NO:31, corresponding to a *dwf5-1* polypeptide.
- C. SEQ ID NO:32 encoding SEQ ID NO:33, corresponding to a *dwf5-2* polypeptide.
- D. SEQ ID NO:34 encoding SEQ ID NO:35 corresponding to a *dwf5-2* polypeptide.
- E. SEQ ID NO:36 encoding SEQ ID NO:37 corresponding to a *dwf5-3* polypeptide.
- F. SEQ ID NO:38 encoding SEQ ID NO:39 corresponding to a *dwf5-4* polypeptide.
- G. SEQ ID NO:40 encoding SEQ ID NO:41 corresponding to a *dwf5-5* polypeptide.
- H. SEQ ID NO:42 encoding SEQ ID NO:43 corresponding to a *dwf5-6* polypeptide.

Inventions I, II and X are unrelated to each other. Applicant is reminded that nucleotide sequences either encoding different proteins or specifying specific expression patterns are structurally distinct chemical compounds and are unrelated to one another, as are different proteins structurally distinct chemical compounds and unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434). This requirement is not

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to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Inventions III-IX are distinct from each other because the starting materials, method steps and end products are distinct and unrelated to each other. Furthermore, the chimeric polypeptide of Invention X could be made by a process other than the method of Invention III, such as chemical synthesis, and the DNA of Invention I and II may be used for a process other than the production of a protein, such as a nucleic acid hybridization. Lastly, DNA and protein differ in composition, structure and function.

Inventions I-II, and X and Inventions III-IX are distinct from each other because the starting materials, method steps and end products are distinct and unrelated to each other.

Each of Inventions I-X are capable of being separately made, independently used, and the patentability of one does not render the others obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart Baum whose telephone number is (703) 305-6997. The examiner can normally be reached on Monday-Friday 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 or (703) 305-3014 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the legal analyst, Kim Davis, whose telephone number is (703) 305-3015

Stuart Baum Ph.D.

June 3, 2002

ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800

Elizabeth F. McElwain